

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Hug, Joshua, et al.	Art Unit	: 3621
Serial No.	: 10/719,981	Examiner	: Murdough, Joshua A.
Filed	: November 21, 2003	Docket	: 108417.00081/RN140
Title	: DIGITAL RIGHTS MANAGEMENT FOR CONTENT RENDERING ON PLAYBACK DEVICES		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Request to Withdraw Finality of Office Action dated February 9, 2009

Applicants are in receipt of a final Office Action mailed February 9, 2009, issued after a Request for Continued Examination or RCE. Applicants respectfully request that the finality of the subject Office Action be withdrawn because the Office has raised new issues to support its finding that the affidavit under 37 C.F.R. 1.131 is insufficient.

In support of this request, Applicants state the following:

- On March 27, 2008, Applicants filed a response to a non-final office action that included an affidavit under 37 C.F.R. § 1.131.
- On June 13, 2008, the Office issued a final office action. In the action, the Examiner found the 131 affidavit insufficient because, according to the Examiner:
 1. The evidence presented with the affidavit was insufficient to show diligent reduction to practice because it did not show dates. June 13 action at page 17.
 2. All listed inventors are required to sign the affidavit. *Id.* at 18.
- On November 13, 2008 Applicants filed an amendment and request for continued examination. The Amendment included a new 131 affidavit that corrected the issues presented by the Examiner in the June 13 action.
- On February 9, 2009, the Office issued a final office action immediately following receipt of the RCE. In the February 9 action, the Examiner raised new grounds for finding the 131 affidavit insufficient. The Examiner's new grounds stated that:
 1. The affidavit did not contain a statement that the invention occurred in the United States. February 9 action at page 2.

The Examiner also found the affidavit insufficient based on an erroneous evidentiary standard. The Examiner erroneously stated that the 131 affidavit must show that the invention was “ready for patenting” in order to prove conception. The Examiner cited section M.P.E.P. § 702.02(l)(2) to support his assertion. However, it is Applicants’ understanding that § 706.02(l)(2) does not relate to 131 affidavits.

None of the Examiner’s grounds for finding the March 27 affidavit insufficient were repeated or applied to the November 13 affidavit.

- On April 1, 2009, Applicants’ counsel and the Examiner conducted a telephonic interview. Applicants respectfully requested withdrawal of the finality of the February 9 action. The Examiner refused to withdraw finality stating that finality was proper after the RCE because entry of the new 131 affidavit did not raise new issues for consideration in the application. The Examiner also stated that, despite the fact that his rationale for finding the 131 affidavit insufficient was based on new grounds, that the new grounds did not preclude entry of a final office action because it is the Applicant’s burden to submit a sufficient 131 affidavit.

The issue in this petition is whether entry of a new 131 affidavit raises new issues within the application such that entry of a final action after an RCE is improper. The M.P.E.P. states:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

M.P.E.P. § 706.07(b).

The M.P.E.P. also states:

However, it would not be proper to make final a first Office action in a continuing or substitute application >or an RCE< where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) *new issues were raised that required further consideration and/or search*, or (B) the issue of new matter was raised.

Id. (emphasis added). The M.P.E.P. guidelines indicate that an application may be finally rejected if the claims were drawn to the same invention as an earlier application (i.e. amendment)

and if those claims would have been properly rejected on the same grounds and art of record. But the M.P.E.P. states an exception: finality is improper where an applicant raises “new issues” that require “further consideration.” The Examiner argues that this exception applies only to new issues regarding the claims. However, the M.P.E.P. states no such limitation. Rather, the M.P.E.P. states that finality is improper after an RCE if the application filed after a final action raises “new issues that require[] further consideration.”

The Applicants’ November 13 affidavit raised new issues that required further consideration. The November 13 affidavit was a new affidavit that corrected the issues raised by the Examiner in the June 13 action. In the June 13 action, the Examiner found the 131 affidavit insufficient because it did not include dates that the Examiner required and because it was not signed by all joint inventors. However, on February 9, the Examiner found new grounds and raised new issues for rejecting the application and finding the November 13 affidavit insufficient. The Examiner did not repeat any of the grounds used to reject the June 13 affidavit. The fact that the Examiner raised new grounds for his findings, and the fact that the old grounds were not applied to the November 13 affidavit, shows that the November 13 affidavit raised new issues that required further consideration. Therefore, the finality of the February 9 action should be withdrawn because the M.P.E.P. states that finality is improper if a response filed after an RCE raises new issues that require further consideration.

The Examiner raised two arguments in the telephonic interview of April 1. First, the Examiner argued that if new issues are to preclude finality, then those new issues must be issues relating to the claims. But the M.P.E.P. does not state this limitation. Rather, the M.P.E.P. states that finality is improper when a response raises new issues that require consideration. Even assuming, *in arguendo*, that the Examiner is correct and that new issues must be related to the claims, a newly filed 131 affidavit does relate to the claims. The affidavit is proof of prior

invention that is used to antedate art—it is a device used to invalidate an examiner's rejection of claims. Therefore, issues relating to the 131 affidavit do relate to the claims. Accordingly, if the 131 affidavit raises new issues for consideration, then finality is improper after an RCE.

Second, the Examiner argues that finality is proper because the 131 affidavit was found insufficient twice, and because it is the Applicant's burden to supply a sufficient 131 affidavit. Applicants agree that it is Applicant's burden to produce a 131 affidavit. However, the Examiner, not the Applicant, makes the determination as to whether the affidavit is sufficient to overcome the art. Here, the Examiner found the first affidavit insufficient. When the Applicants supplied a new affidavit after filing an RCE that addressed all of the Examiner's concerns, the Examiner found new grounds to reject the newly filed affidavit. A final office action is improper where the Examiner raises new grounds for rejecting an application immediately after the Applicant has filed an RCE. M.P.E.P. § 706.07(b). Accordingly, Applicants respectfully request withdrawal of the finality of the February 9, 2009 action.

Respectfully Submitted,

Dated: 07 April 2009

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